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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,090	10/14/2007	Octavian Schatz	BOH06278P00220US	7674
38939	7590	09/01/2010		
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			EXAMINER CHUNDURU, SURYAPRABHA	
			ART UNIT 1637	PAPER NUMBER
			MAIL DATE 09/01/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,090	<b>Applicant(s)</b> SCHATZ ET AL.	
	<b>Examiner</b> Suryaprabha Chunduru	<b>Art Unit</b> 1637	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. Applicant's response filed on June 23, 2010 has been considered and acknowledged.

***Status of the Application***

2. Claims 1-13 are pending under examination. Claims 1-2, 8 are amended. Claims 14-67 are cancelled. All arguments and amendment have been fully considered and thoroughly reviewed and deemed persuasive in part for the reasons that follow. This action is made Non-Final.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Schatz et al. (US 2006/0194202 A1).

Schatz et al. teach a method for manufacturing of a nucleic acid molecule of claim 1, comprising

a) providing a first at least partially double stranded oligonucleotide comprising a first and a second single stranded overhang (see page 2, paragraph 0032, page 7-8, paragraph 0131, claim 23 step a) on page 37);

b) providing a second at least partially double stranded oligonucleotide that comprises a first type IIS restriction enzyme recognition site and a modification that allows the oligonucleotide to be coupled to a surface and a single stranded overhang (see page 2, paragraph 0033, page 8, paragraph 0132-0133, claim 23 step b) on page 37);

c) ligating the first and the second oligonucleotides via the single strand overhangs to form a first ligation product (see page 2, paragraph 0034, claim 23 step c) on page 37);

d) cutting the first ligation product with the type IIS restriction enzyme releasing an elongated first partially double stranded oligonucleotide having a first and second single strand overhang and a truncated second partially double-stranded oligonucleotide (see page 2, paragraph 0035, claim 23 step e) on page 37);

e) immobilizing the truncated second partially double-stranded oligonucleotide, the unreacted second partially double-stranded oligonucleotide and/or uncut first ligation product via the modification to a surface (page 2, paragraph 0036, claim 23 step g) on page 37);

f) repeating steps a) to e) (see page 3, paragraph 0040, claim 23 step i) on page 37).

With regard to claim 2-3, Schatz et al. teach that the first ligation product is immobilized via the long single-strand overhang (see page 9, paragraph 0136).

With regard to claim 4, Schatz et al. teach that the method comprises washing the immobilized first ligation product and separating it from the surface (see page 15, paragraph 0178).

With regard to claim 5-8, Schatz et al. teach that the first overhang comprises a length of 1, 2, 3, 4, 5, 6 or 7 nucleotides and the first and second overhangs of the first oligonucleotide allows stable hybridization (see page 3, paragraph 0042).

With regard to claim 9-11, Schatz et al. teach that the modification is biotin modification and interaction with the support occurs via biotin modification and the interaction group comprises streptavidin (see page 9, paragraph 0136).

With regard to claim 12, Schatz et al. teach that a part of nucleic acid to be manufactured is part of the elongated first partially double stranded oligonucleotide (see page 9, paragraph 0138).

With regard to claim 13, Schatz et al. teach that the steps a) to e) are repeated at least once and the nucleotides transferred from the second and any partially double stranded oligonucleotides provided in step b) to the first oligonucleotide are the nucleic acid to be manufactured or part thereof (see page 9, paragraph 0138). Accordingly the claims are anticipated.

***Response to arguments:***

4. With regard to the foreign priority, Applicants submission of certified copies of the foreign priority papers have been considered and acknowledged.
5. With regard to the objection to the specification, Applicants' arguments and amendment are fully considered and found persuasive and the objection is withdrawn herein in view of the amendment.
6. With regard to the rejection of claims 1-13 under 35 USC 112, second paragraph, Applicants' arguments and the amendment were fully considered and found persuasive and the rejection is withdrawn in view of the amendment.

7. With regard to the rejection of claims 1-13 under 35 U.S.C. 102(a) as being anticipated by Schatz et al. based on EP 1 411 122 A1, Applicants' arguments and the priority papers have been fully considered and the rejection is withdrawn herein in view of the amendment.

8. With regard to the rejection of claims under 35 U.S.C. 102(b) as being anticipated by Schatz et al. based on US 2006/0115850 A1, Applicants' arguments and the amendment were fully considered and the rejection is withdrawn herein in view of persuasive arguments drawn to oligonucleotide having a first and a second single-stranded overhang.

9. With regard to the rejection of claims 1-13 under 35 U.S.C. 102(e) as being anticipated by Schatz et al. (US 2006/0194202 A1), Applicants' arguments have been fully considered and found unpersuasive. The cited portions of Schatz et al. does teach oligonucleotide having a first and a second single-stranded overhang because one end of said oligonucleotide is modified to allow coupling to a surface or blocked to allow ligation of the second oligonucleotide to unblocked end of the overhang and page 7-8, paragraph 0131 teaches that the oligonucleotide library comprising oligonucleotides having 3' and 5' end single-stranded overhangs. The rejection is maintained and re-written to incorporate the limitations as above.

### ***Conclusion***

No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Suryaprabha Chunduru/

Primary Examiner, Art Unit 1637